BLANK
PAGE

Office-Supreme Court, U.S.
FILED
APR 19 1966
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No. 1092

UNIVERSAL MARION CORPORATION,

Petitioner,

vs.

THE WARNER & SWASEY COMPANY, et al.,

Respondents.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE TENTH CIRCUIT

PETITIONER'S REPLY TO RESPONDENTS' BRIEF IN OPPOSITION

ROBERT MCKAY,
Attorney for Petitioner,
330 Madison Avenue,
New York, New York 10017.

Of Counsel:

PENNIE, EDMONDS, MORTON,
TAYLOR AND ADAMS,
New York, New York.

HARRY C. JONES, III,
New York, New York.

ACKERMAN PRESS, Phones BO 9-7107-8

IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No. 1092

UNIVERSAL MARION CORPORATION,

Petitioner,

vs.

THE WARNER & SWASEY COMPANY, et al.,

Respondents.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE TENTH CIRCUIT

PETITIONER'S REPLY TO RESPONDENTS' BRIEF IN OPPOSITION

Respondents, on page 19, state that the cases cited by petitioner on pages 10 and 11 of its Petition are not relevant to show non-uniformity of the several circuits in applying the *law of experimental use*. Respondents' argument misses the target. Petitioner's Question I is more basic than this and concerns itself with whether the legal principles as expressed in *Elizabeth* v. *Pavement Co.*, 97 U. S. 126 (1877) are applicable today for determining whether a prior nonsecretive commercial, competitive use of an invention is or is not a "public use" within the meaning of 35 U. S. C. § 102(b).

This Court in *Elizabeth* v. *Pavement Co.*, *supra*, created a judicial exception to 35 U. S. C. § 102(b) by holding that a prior public use of an invention does not fall

within the prohibition of the statute if such use is experimental. Some Courts of Appeals, when presented with a question of public use, have cited and applied the rule of *Elizabeth* to avoid the invalidating effect of the statute. Other courts have considered prior uses which previously were not considered public within the meaning of 35 U. S. C. § 102(b) as, in fact, being such if they amount to a competitive exploitation of the invention.

The Court of Appeals for the Second Circuit in *Metallizing Engineer Co.* v. *Kenyon Bearing & A. P. Co.*, 153 F. 2d 516 (1946), *cert. denied* 328 U. S. 840 (1946) held that the sale of a product made by a secret process amounted to a competitive exploitation of the secret process and thus the process was "publicly used" within the meaning of 35 U. S. C. § 102(b). It found such use of the process to be in violation of the statute even though the public could not ascertain from an examination of the product the process by which it was produced. The broad application of this holding, irrespective of the secrecy or non-secrecy of the use, has effected at least a partial erosion of the doctrine established by the *Elizabeth* case as under the *Metallizing* case, any competitive exploitation of an invention outside the one-year period provided for in the statute results in a forfeiture of any patent rights under § 102(b) regardless of the secret or experimental nature of the activity. The third and sixth circuits in *U. S. Chemical Corp.* v. *Plastics Glass Corp.*, 243 F. 2d 892 (3 Cir. 1957), *cert. denied* 357 U. S. 836 (1957) and *Huszar* v. *Cincinnati Chemical Works*, 172 F. 2d 6 (6 Cir. 1949) have followed the rule of the *Metallizing* case.

Respondents refer to limited claims of the patent in suit and state that the machine used one year prior to filing of the application for patent did not include certain specific features called for in *these* claims. Such argument is *not* applicable to the broad claims. (See claim 6, for example, p. 68a.) The specific features of the limited

claims are however minor; and it is clear that the machine used more than one year *prior* to the time the patent application was filed did, in fact, have all of the features of the broad claims involved in this suit and that the machine anticipated the "invention" or asserted patentability attributable to the machine. In this regard, the District Court did find that there was a "limited use" of the "*invention*" (emphasis added) more than one year prior to the filing of the patent application (p. 44a). This being the case, the broad claims should be held invalid under 35 U. S. C. §102(b) and the subject matter of these claims should constitute "prior art" for invalidating the specific claims.

It is submitted that this Court should review the law of prior public use because of the importance of this doctrine in the administration of the patent system.

CONCLUSION

For the reasons stated herein and in the Petition for Writ of Certiorari, such Petition should be granted.

Respectfully submitted,

ROBERT MCKAY,
Attorney for Petitioner,
330 Madison Avenue,
New York, New York 10017.

Of Counsel:

PENNIE, EDMONDS, MORTON,
TAYLOR and ADAMS,
New York, New York,

HARRY C. JONES, III,
New York, New York.